

REMARKS

Applicant is in receipt of the Office Action mailed May 26, 2006. Claims 3, 6 and 19 have been amended. Claims 1-25 remain pending in the application.

Claims 3, 6 and 19 have been amended to consistently refer to "computing environment."

REJECTIONS UNDER 35 U.S.C. §103

Claims 1-5, 9-13, 17-21 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yemini et al. (U.S. Patent No. 6,249,755, hereinafter 'Yemini') and Garnett, K. et al. (U.S. Patent No. 6,856,942, hereinafter 'Garnett').

Regarding independent claim 1, the Examiner acknowledges that Yemini does not teach features recited in these claims.

Yemini does not explicitly teach monitoring the computing environment to determine whether any of the set of outcomes has occurred and reporting that one or more of the predicted set of outcomes has occurred.

(See Office Action from May 26, 2006, page 3, lines 1-3).

However, the Examiner then asserts that Garnett teaches these features. Applicant respectfully disagrees and submits that Garnett does not teach or suggest either "monitoring ... **to determine** whether any of the set of outcomes has occurred" or "reporting that one or more of **the predicted set of outcomes** has occurred," as recited in claim 1. In contrast, Garnett teaches "a system, method and computer program for monitoring and troubleshooting applications in a computing environment" (see Garnett, col. 2, lines 54-56), and that "...data gathered...by diagnosers is analyzed...to identify one or more root causes of the issue" (see Garnett, col. 6, lines 50-58). Applicant submits that "the set of outcomes" as recited in claim 1 refers to the antecedent feature "in response to detecting said change, predicting a set of outcomes resulting from said change", which appears different from "[u]pon receiving stimuli...start troubleshooting the issue" as in Garnett, col. 6, lines 9-10.

To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP §2143.03. Applicant submits that not all the features in claim 1 are disclosed or suggested by Yemini or Garnett, taken singly or in combination.

Even if *in arguendo* Garnett is assumed to teach the features in claim 1 as asserted by the Examiner, which Applicant submits is not the case, there does not appear to be any teaching or suggestion to make the specific combination of Garnett with Yemini as claimed.

Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The Examiner's cited motivation to combine "to reduce the time it takes to find and fix issues and prevent many issues from even occurring" (see Office Action from May 26, 2006, page 3, lines 4-7) appears to be a broad conclusory statement regarding improvements in efficiency, which could cover almost any alteration of Yemini. The Examiner's purported motivation to combine Garnett with Yemini appears too general and does not address why this specific proposed modification would have been obvious.

As a result of the foregoing, Applicant respectfully submits that a *prima facie* case of obviousness has not been established against claim 1, along with its dependent claims. Independent claims 9, 17 and 25, along with their respective dependent claims, appear allowable for at least the reasons presented in support of claim 1. Removal of the rejection under §103 is kindly requested.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5760-14800/BNK.

Respectfully submitted,

A handwritten signature in dark ink, appearing to be "B. Noël Kivlin", written over a horizontal line.

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